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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/915,719

07/25/2001

James A. Parker

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6795

26362

7590

11/27/2007

LOUIS J. HOFFMAN, P.C.

11811 North Tatum Boulevard, Suite 2100

Phoenix, AZ 85028

EXAMINER

MANIWANG, JOSEPH R

ART UNIT

PAPER NUMBER

2144

NOTIFICATION DATE

DELIVERY MODE

11/27/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

Application No.

09/915,719

Applicant(s)

PARKER, JAMES A.

Examiner

Joseph R. Maniwang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25, 29-33, 37, 38 and 44-56 is/are pending in the application.
- 4a) Of the above claim(s) 29-33, 37, 38 and 49-52 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-25, 44-48, 55 and 56 is/are allowed.
- 6) ☒ Claim(s) 53 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date 20071120.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 53 and 54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Independent claim 53 directed to "An apparatus comprising: (1) an Internet computer along a transmission path between a source computer and a destination computer on the Internet computer network; and (2) a data stream in transit through the Internet computer, the data stream encoding data arranged in a plurality of data frames and comprising: (a) header data...; (b) data...; (c) data...; (d) data...; and (e) data..." is rejected under 35 U.S.C. 101 for the following reasons:

4. A. The claim is specifically directed to a "data stream in transit through" an "Internet computer", which claims a signal (i.e., the "data stream") in a transitory state or transmission medium (i.e., the "Internet computer"). Paragraph [0047] of the Specification provides evidence that such a medium is intended to include signals and as such is drawn to a form of energy ("suitable connections include...spread-spectrum wireless (infrared or RF), RF satellite relay"). Energy is not one of the four categories of invention and therefore renders the claim non-statutory. Energy is not a physical article or object, machine, or manufacture.

5. B. There is no practical application making available a useful, concrete, and tangible result to realize any usefulness. The claim is directed to data in a transitory state, failing to provide concrete functionality. Furthermore, the various recited "data/frames" is non-functional descriptive material as it is a mere arrangement of data, and is therefore non-statutory. When non-functional descriptive material is recorded on some computer-readable medium, in a computer, or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement.

***Allowable Subject Matter***

6. Claims 1-25, 44-48, 55 and 56 are allowed.

7. Regarding claims 1-14 and 44-48, the Examiner's reasons for allowance are stated in a previous action.

8. Regarding claims 15-25 and 55-56, of which 15, 16, 22, 26, and 55 are independent, Examiner relies on the previously stated reasons for allowance in allowing these claims. The claims in general recite similar provisions as the previously allowed claims for the separate designation of addresses indicating a recipient, authorized viewers, and authorized editors of an e-mail message and associated attachment. This feature in combination with all the limitations together within the independent claims is not fairly taught or suggested by the prior art of record. Therefore, the independent claims 15, 16, 22, 26, and 55 have allowable subject matter and are allowable over the prior art of record.

***Response to Arguments***

9. Applicant's arguments filed 08/30/07 have been fully considered but they are not persuasive.

10. Regarding claims 53 and 54 rejected under 35 U.S.C. 101, the rejection of the claims is maintained for the reasons detailed above. In the remarks filed 08/30/07, Applicant's first assertion regarding this claim is that the claimed "Internet computer" is directed to tangible equipment and is therefore statutory as it is a "machine/manufacture". However, Examiner submits that in light of the Specification and as detailed above, the "Internet computer" in this case clearly serves as merely a "transmission media", which is intended to include wireless mediums (see Specification paragraph [0047]). Furthermore, the claim as a whole lacks functionality. As evident from Applicant's remarks, the claims intend to cover a signal that temporarily resides in a transmission media (i.e., the "Internet computer") and only "has functionality when applied to appropriately configured destination equipment" (Remarks 08/30/07, p. 16). It is first noted that such a provision (i.e., a destination computer to which the signal/data stream is applied to) is not recited in the claims. Instead, as detailed above, the claims are directed solely to a "data stream in transit" through an "Internet computer". In addition, the claimed data elements, passing through a computer/medium or not, do not impart any functionality whatsoever on any implied destination computer or the like, but instead is clearly directed to "identifying" a particular computer (but itself does not cause a computer to perform the identification) or data representing a body of

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an e-mail. Clearly, these elements of the claim are nothing more than a mere arrangement of data, which is non-functional descriptive material and therefore non-statutory as it fails to meet the practical application requirement. Regardless of the embodiment in which they are claimed, the claimed data arrangement cannot be statutory, as merely claiming such non-functional descriptive material stored in a computer-readable medium, in a computer, or on a signal would exalt form over substance. Finally, although Applicant likens the claim to a program resident in a computer or on a computer disk, the provision for storing the data is not present in the claim language. In fact, the exact opposite is claimed, where the data is "in transit" (i.e., temporary) which does not necessarily place the data to be stored anywhere. Moreover, any storage of the claimed data in the claimed "Internet computer" or otherwise would be intended use, as no such provision is explicitly recited in the claims.

### ***Conclusion***

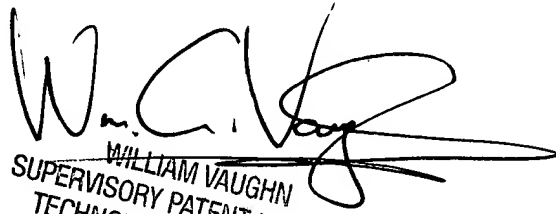
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM

  
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SUPERVISORY PATENT EXAMINER  
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